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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/814,304	03/21/2001	Robert A. Miller	10004450-1	4826
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HEWLETT-PACKARD COMPANY Intellectual Property Administration P.O. Box 272400 Fort Collins, CO 80527-2400			HUTTON JR, WILLIAM D	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 03/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/814,304	MILLER, ROBERT A.
	Examiner Doug Hutton	Art Unit 2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 05 January 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 27-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 27,29-31,33-36 and 41-48 is/are rejected.
- 7) Claim(s) 28,32 and 37-40 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 21 March 2001 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____ .

DETAILED ACTION

Applicant's Response

In Applicant's Response dated 01/06/2006, Applicant amended Claim 27, added new Claims 35-48, cancelled Claims 1-26, and argued against all rejections previously set forth in the Office Action dated 10/05/2005.

All 101 rejections are withdrawn. All prior art rejections based on Kojima (US 6,633,401) are withdrawn.

Claim Objections

Claims 28, 32, 37 and 38 are objected to because of the following informalities:

- In Claim 28, the phrase “*until a maximum of permitted change*” in Line 4 should be amended to — until [[a]] the maximum of permitted change — because the “*maximum of permitted change*” is previously recited in the claim (see Lines 1-2). Claims 32, 37 and 38 have the same problem.

Claim 41 is objected to because of the following informalities:

- The phrase “*configured to change data*” in Lines 5-6 should be amended to — configured to change the data — because the “*data*” is previously recited in the claim (see Line 4).

- The phrase “*when applied to data*” in Lines 6-7 should be amended to — when applied to the data — because the “*data*” is previously recited in the claim (see Line 4).

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 27, 30, 31 and 34 remain rejected under 35 U.S.C. 102(e) as being anticipated by Mercer.

Claim 27:

Mercer discloses a *computerized method of formatting print data* (see Figures 1-2; see Column 3, Line 62 through Column 5, Line 32 – Mercer discloses this limitation in that the text display system comprises computer hardware and software that processes and displays documents on a cellular telephone display screen, as clearly indicated in the cited figures and text. The documents are “*print data.*”), *comprising:*

- *establishing a higher level formatting rule for the print data* (see Figures 3A-D; see Column 5, Line 33 through Column 6, Line 34 – Mercer discloses this limitation in that the system includes Maximize Text Displayed software comprising a vertical distance reduction method, a font substitution method and a horizontal distance reduction method. The maximization of the displayed text performed by the Maximize Text Displayed software is the “*higher level formatting rule.*”);
- *establishing lower level formatting rules configured to change the print data to conform to the higher level rule* (see Figures 3A-D; see Column 5, Line 33 through Column 6, Line 34 – Mercer discloses this limitation in that the system includes Maximize Text Displayed software comprising a vertical distance reduction method, a font substitution method and a horizontal distance reduction method. The methods are the “*lower level formatting rules.*”);
- *establishing a fail safe rule that when applied to the print data conforms the print data to the higher level rule* (Mercer discloses this limitation in that the methods for maximizing the text displayed are executed in conjunction with a browser. The browser **inherently** comprises a “*fail safe rule*” in that either the methods will fully execute with no problem and the browser will display the web page, or, upon encountering any problem during execution of the methods that will not permit display of the web page, the browser displays an error message. Accordingly, either the rules will execute and the web page is displayed, or the rules will not execute and an error message is displayed. Whenever the rules execute and the

web page is displayed, the “*fail safe rule*” is “*applied to the print data*” and “*conforms the print data to the higher level rule.*”);

- *applying the lower level rules to the print data* (see Figures 3A-D; see Column 5, Line 33 through Column 6, Line 34 – Mercer discloses this limitation, as clearly indicated in the cited figures and text); and
- *applying the fail safe rule to the print data if applying the lower level rules to the print data does not conform the print data to the higher level rule* (as indicated in the above discussion, the “*fail safe rule*” will be applied upon encountering any problem during execution of the methods that will not permit display of the web page).

Claim 30:

Mercer discloses *the method of Claim 27 wherein the print data comprises data representing one or more of static text, dynamic text, static graphics or dynamic graphics* (see Figures 3A and 3B – Mercer discloses this limitation, as clearly indicated in the cited figures).

Claims 31 and 34:

Claims 31 and 34 recite computer software comprising the method recited in Claims 27 and 30, respectively. Thus, because the invention disclosed in Mercer involves processes executed by software, Mercer discloses every limitation of Claims 31 and 34, as indicated in the above rejections for Claims 27 and 30.

Claims 35, 36, 41-43 and 45-48 are rejected under 35 U.S.C. 102(e) as being anticipated by Mercer.

Claim 35:

Mercer discloses *the method of Claim 27* (Mercer discloses every limitation of Claim 27, as indicated in the above rejection), *wherein the higher level formatting rule comprises fitting all of the print data on one page* (see Figures 5-8; see Column 7, Line 1 through Column 9, Line 10 – Mercer discloses this limitation in that the software retrieves a web page from the Internet that will not fit onto a small display and fits the web page data onto one page of the display screen.) *and the lower level formatting rules include two or more of reducing a font, shrinking photos and graphics proportional with a font, reducing a length of some data fields, or shrinking a margin* (see Figures 5-8; see Column 7, Line 1 through Column 9, Line 10 – Mercer discloses this limitation in that the software comprises methods including “sub-checkers” that reduce the font of the web page text and reduce the horizontal and vertical distances of data fields in the web page).

Claim 36:

Claim 36 recites computer software comprising the method recited in Claim 35. Thus, because the invention disclosed in Mercer involves processes executed by software, Mercer discloses every limitation of Claim 36, as indicated in the above rejection for Claim 35.

Claim 41:

Mercer discloses, *in a system for creating documents from processed data, an apparatus for forming processed data* (see Figures 1-2; see Column 3, Line 62 through Column 5, Line 32 – Mercer discloses this limitation in that the text display system comprises computer hardware and software that processes and displays web pages on a cellular telephone display screen, as clearly indicated in the cited figures and text.

The web pages comprise “*processed data.*”), *comprising:*

- *a data storage device* (see Column 3, Line 62 through Column 5, Line 32 – Mercer discloses this limitation in that the system displays web pages using the Internet. The Internet web pages comprise “*processed data*” and are stored in various “*data storage devices*, such as web servers.);
- *a form engine connected to said data storage device processing data according to a higher level formatting rule* (see Figures 3A-D; see Column 5, Line 33 through Column 6, Line 34 – Mercer discloses this limitation in that the system includes Maximize Text Displayed software comprising a vertical distance reduction method, a font substitution method and a horizontal distance reduction method. The maximization of the displayed text performed by the Maximize Text Displayed software is the “*higher level formatting rule.*”), *lower level formatting rules configured to change data to conform to the higher level rule* (see Figures 3A-D; see Column 5, Line 33 through Column 6, Line 34 – Mercer discloses this limitation in that the system includes Maximize Text Displayed software comprising a vertical distance reduction method, a font substitution method and a

horizontal distance reduction method. Each of the methods are a “*lower level formatting rule*”), and a *fail safe rule* that when applied to data conforms the data to the higher level rule (Mercer discloses this limitation in that the methods for maximizing the text displayed are executed in conjunction with a browser. The browser *inherently* comprises a “*fail safe rule*” in that either the methods will fully execute with no problem and the browser will display the web page, or, upon encountering any problem during execution of the methods that will not permit display of the web page, the browser displays an error message. Accordingly, either the rules will execute and the web page is displayed, or the rules will not execute and an error message is displayed. Whenever the rules execute and the web page is displayed, the “*fail safe rule*” is “*applied to the print data*” and “*conforms the print data to the higher level rule*”), wherein the *fail safe rule* is applied to the data only if applying the lower level rules to the data does not conform the data to the higher level rule (as indicated in the above discussion, the “*fail safe rule*” will be applied upon encountering any problem during execution of the methods that will not permit display of the web page), and

- an output device connected to the form engine for outputting formatted data processed by the form engine (see Figure 1A – Mercer discloses this limitation in that the system comprises a cellular telephone screen that displays the web page in the revised format).

Claim 42:

Mercer discloses *the apparatus of Claim 41, wherein the data processed by the form engine comprises print data* (see Figures 1-2; see Column 3, Line 62 through Column 5, Line 32 – Mercer discloses this limitation in that the text display system comprises hardware and software that processes and displays web pages on a cellular telephone display screen, as clearly indicated in the cited figures and text. The web pages are “*print data.*”).

Claim 43:

Mercer discloses *the apparatus of Claim 41, wherein each lower rule is applied until the rule is met or until a maximum of permitted change for the rule is reached, whichever occurs first* (see Figures 4-8; see Column 6, Line 35 through Column 9, Line 10 – Mercer discloses this limitation in that the system performs each step of each method until the “*rule is met.*” In the embodiment discussed in the cited figures and text, the methods are “*applied until met.*” Thus, each rule is applied “until the rule is met” or “until a maximum of permitted change for the rule is reached,” “whichever occurs first.” In this case, the application of the “*rule*” “*until [the rule is] met*” “occurs first.”).

Claim 45:

Claim 45 recites an apparatus that performs the method recited in Claim 35. Thus, because the invention disclosed in Mercer involves computers that perform the

method, Mercer discloses every limitation of Claim 45, as indicated in the above rejection for Claim 35.

Claim 46:

Mercer discloses, *in a system for creating documents from processed data, an apparatus for forming processed data* (see Figures 1-2; see Column 3, Line 62 through Column 5, Line 32 – Mercer discloses this limitation in that the text display system comprises hardware and software that processes and displays documents on a cellular telephone display screen, as clearly indicated in the cited figures and text), *comprising:*

- *a data storage device* (see Column 3, Line 62 through Column 5, Line 32 – Mercer discloses this limitation in that the system displays web pages using the Internet. The Internet web pages comprise “*processed data*” and are stored in various “*data storage devices*,” such as web servers.);
- *a form engine connected to said data storage device for processing data according to a higher level formatting rule* (see Figures 3A-D; see Column 5, Line 33 through Column 6, Line 34 – Mercer discloses this limitation in that the system includes Maximize Text Displayed software comprising a vertical distance reduction method, a font substitution method and a horizontal distance reduction method. The Maximize Text Displayed software is the “*form engine*,” and each of the methods are “*higher level formatting rules*.”) and a lower level formatting rule configured to change data to conform to the higher level rule (see Figures 3A-D; see Column 5, Line 33 through Column 6, Line 34 – Mercer discloses this

limitation in that the system includes Maximize Text Displayed software comprising a vertical distance reduction method, a font substitution method and a horizontal distance reduction method. Each of the methods is a "*lower level formatting rule.*"), wherein the *lower level rule is applied until the rule is met or until a maximum of permitted change for the rule is reached, whichever occurs first* (see Figures 4-8; see Column 6, Line 35 through Column 9, Line 10 – Mercer discloses this limitation in that the system performs each step of each method until the "*rule is met.*" In the embodiment discussed in the cited figures and text, the methods are "*applied until met.*" Thus, the "*rules*" are applied "*until [the rules are] met*" or "*until a maximum of permitted change for the rule is reached,*" whichever "*occurs first.*" In this case, "*applying the rules until they are met*" occurs first.); and

- *an output device connected to the form engine for outputting formatted data processed by the form engine* (see Figure 1A – Mercer discloses this limitation in that the system comprises a cellular telephone screen that displays the web page in the revised format).

Claim 47:

Mercer discloses *the apparatus of Claim 46, wherein the form engine further processes data according to a fail safe rule that when applied to the data conforms the data to the higher level rule, the fail safe rule being applied to the data only if applying*

the lower level rule to the data does not conform the data to the higher level rule (as indicated in the above rejection for Claim 27, Mercer discloses this limitation).

Claim 48:

Mercer discloses *the apparatus of Claim 46, wherein the data processed by the form engine comprises print data* (as indicated in the above rejection for Claim 27, Mercer discloses this limitation).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 29, 33 and 44 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Mercer.

Claim 29:

As indicated in the above discussion, Mercer discloses every element of Claim 27.

Mercer fails to expressly disclose a higher level formatting rule that comprises *fitting all of the print data on one page* and a fail safe rule that comprises *cutting the print data*. However, at the time the invention was made, it would have been obvious to

one having ordinary skill in the art (i.e., a computer programmer) to have employed a higher level formatting rule that comprises *fitting all of the print data on one page* and a fail safe rule that comprises *cutting the print data*. If a computer programmer wanted to ensure that a print job comprised printing the print job data onto a single sheet, then he could have selected from among some obvious design choices. These obvious design choices included: 1) reducing the size of the print data; 2) changing the font of the print data; 3) reducing/eliminating the margins of the print data; and/or 4) deleting portions of the print data. All of these obvious design choices comprised "*cutting the print data*" and would have been employed by a computer programmer for the purpose of ensuring that a print job produced only a single page of print data.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus, disclosed in Mercer, to include a higher level formatting rule that comprises *fitting all of the print data on one page* and a fail safe rule that comprises *cutting the print data*, for the purpose of ensuring that a print job produced only a single page of print data

Claim 33:

Claim 33 recites computer software comprising the method recited in Claim 29. Thus, because the invention disclosed in Mercer involves processes executed by software, Mercer discloses every limitation of Claim 33, as indicated in the above rejection for Claim 29.

Claim 44:

Claim 44 recites an apparatus that performs the method recited in Claim 29. Thus, because the invention disclosed in Mercer involves computers that perform the method, Mercer discloses every limitation of Claim 44, as indicated in the above rejection for Claim 29.

Allowable Subject Matter

Claims 28 and 32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 37-40 are objected to based on minor informalities, but would be allowable if rewritten to overcome the objections.

The following is a statement of reasons for the indication of allowable subject matter:

Claims 28, 32 and 37-40:

The prior art fails to disclose or suggest the combination of limitations recited in Claims 28, 32 and 37-40.

Response to Arguments

Applicant's arguments filed 01/05/2006 have been fully considered but they are not persuasive.

Arguments for Claims 27, 30, 31 and 34 (Rejections Based on Mercer):

Applicant argues that Mercer fails to disclose every limitation of the claims because the browser disclosed in Mercer does not inherently include a "fail safe rule." Applicant supports the argument by observing that the examiner did not meet the requirements of inherency in that a "fail safe rule" is not necessary in the system of Mercer. Additionally, Applicant supports the argument by observing that the examiner's inherency argument is not factually correct in that Mercer does not suggest that the lower level rules might fail to fully execute. See Response – Page 8, second paragraph through Page 9, first partial paragraph.

The examiner disagrees.

The examiner notes that the lines between all "rules" in Applicant's invention are somewhat vague, which is the nature of the art of computer programming. Simply reciting in the claims that some rules are "high level," "low level" and "fail safe" does not significantly narrow the scope of the claims.

Mercer expressly discloses a web browser. A browser is used to display electronic information. The browser executes "*high level rules*" to display the electronic information. The highest level rule of the browser *inherently* includes a rule that displays electronic information. All "*lower level rules*" are executed in order to satisfy

the “*higher level rule*.” Thus, whenever any type of electronic information, including all information that is displayable by a web browser, is displayed by the browser, “*lower level rules*” are executing to satisfy the “*higher level rule*.”

At a minimum, it was well-known by one of ordinary skill in the art (e.g., computer programmers) at the time the invention was made that web browsers must display **something** on the display screen whenever a user attempts to access a web page. This is what the examiner was attempting to identify as “inherent” in the art of web browsers. Stated differently, if the browser in Mercer cannot “*conform the print data to the higher level rule*” using the “*lower level rules*” (see Claim 27, Lines 9-10), then the browser resorts to a “*fail safe rule*” and displays something on the display screen (e.g., a 404 error message) that “*conforms to the higher level rule*” of displaying **something** whenever the user attempts to access a web page.

Accordingly, Mercer discloses every limitation of Claims 27, 30, 31 and 34.

Arguments for Claims 27, 30, 31 and 34 (Rejections Based on Kojima):

The examiner has withdrawn the prior art rejections based on Kojima. Thus, these arguments are moot.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doug Hutton whose telephone number is 571-272-4137. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

WDH
March 20, 2006



**DOUG HUTTON
PRIMARY EXAMINER
TECH CENTER 2100**